

### **REMARKS/ARGUMENTS**

The Applicants have carefully considered this Application in connection with the Examiner's Action and respectfully request reconsideration of this Application in view of the foregoing amendment and the following remarks.

The Applicants originally submitted Claims 1-21 in the Application. The Applicants have amended Claims 1-7, 8 and 15. Accordingly, Claims 1-21 are currently pending in the Application.

#### **I. Rejection of Claims 2-7 under 35 U.S.C. §112, Second Paragraph**

Claims 2-7 are rejected under 35 U.S.C. §112, Second Paragraph, by the Examiner for the reason that recitations of the element “the player” purportedly lacks sufficient antecedent basis. The Applicants amend Claims 2-7 to recite a “*media and advertisement player*”. The Applicants therefore respectfully request that the Examiner withdraw the 35 U.S.C. §112, Second Paragraph rejection of these claims.

#### **II. Rejection of Claims 8-14 under 35 U.S.C. §101**

Claims 8-14 are rejected under 35 U.S.C. §101 by the Examiner because purportedly Claims 8-14 are directed to non-statutory subject matter. The Examiner states that “The claims, as currently written, lack usefulness... The steps are directed to providing pieces that could be assembled at some point... However, the claimed pieces are never made operational and never interact with one another.” (Examiner's Action, page 2).

According to the M.P.E.P §2107.01 “General Principles Governing Utility Rejections:

Deficiencies under the “useful invention” requirement will arise in one of two forms. The first is where it is not apparent why the invention is “useful”. This can occur when an applicant fails to identify any specific and substantial utility for the invention or fails to disclose enough information about the invention to make its usefulness immediately apparent to those familiar with the technological field of the invention ... The second type of deficiency arises in the rare instance where an assertion of specific and substantial utility for the invention made by the applicant is not credible.

According to M.P.E.P §2107 “Guidelines for Examination of Applications for Compliance with the Utility Requirement II. Examination Guidelines for the Utility Requirement: (3):

If... it becomes readily apparent that the claimed invention has a well-established utility, do not impose a rejection based on lack of utility. An invention has a well-established utility if (i) a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention (e.g., properties or applications of a product or process), and (ii) the utility is specific, substantial, and credible.

In Claims 8-14, a method of manufacturing a media and advertisement player is claimed. A specific and substantial utility of the method is to manufacture a media and advertisement player capable of playing both media and advertisements, wherein in some embodiments, and report the media and advertisements that the media and advertisements it plays to a remote system. The Applicants respectfully state that this above recitations of utility of the claimed inventions meet the ‘utility’ requirements under 35 U.S.C. §101, as further delineated in the above passages of the M.P.E.P.

Furthermore, the Applicants respectfully disagree with the above characterizations of Claims 8-14 made by the Examiner, and the Applicants respectfully state that the claimed pieces *do* operate with one another. For instance, in independent Claim 8, the media player “receives media from a remote system,” the advertisement player subsystem “receives advertisements and a

corresponding advertising schedule from said remote system”, and the tracking subsystem “records a playing of said media and said advertisements...” The Applicants respectfully contend that the above relationships, for example, do demonstrate that the claimed pieces operate with one another.

The Applicants therefore respectfully request that the Examiner to withdraw the 35 U.S.C. §101 rejection of these claims.

### **III. Rejection of Claims 2-7 1 under 35 U.S.C. §102**

The Examiner has rejected Claims 1-21 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,845,897 Radziewicz *et al.* (“Radziewicz”). As the Examiner is no doubt aware, anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference; the disclosed elements must either be disclosed expressly or inherently and must be arranged as in the rejected claims.

Claim 1 as amended is directed to a media and advertisement player for use with a computer network. The media and advertisement player comprises a media player that receives media from a remote system via the computer network and plays the media in response to customer requests, *wherein the media is selected from the group consisting of: audio music and music videos*. The media and advertisement player further comprises an advertisement player that receives advertisements and a corresponding advertising schedule from the remote system via the computer network and plays the advertisements according to the advertising schedule. The media and advertisement player further comprises a tracking subsystem that generates as-run logs containing records of a playing of the media and the advertisements and transmits the as-run logs to the remote

system via the computer network. (Emphasis added).

Radziewicz is generally directed to “a network communications marketing system which provides announcements to a station whenever the station or line connecting the station to a communications network is idle... The announcements are provided until the station until the station or line is no longer idle.” (Column 2, lines 3-8).

In Radziewicz, a data terminal equipment (“DTE”) 14 interacts with a network service provider (“NSP”) 16. Advertisements are transmitted to the DTE 14 whenever a connection path 20 is idle, with the DTE displaying the advertisements. (Column 5, lines 47-54). However, Radziewicz does not disclose or suggest a media player that receives media from a remote system via the computer network and plays the media in response to customer requests, *wherein the media is selected from the group consisting of: audio music and music videos*, as is claimed in amended Claim 1.

Furthermore, the Examiner has stated that Radziewicz discloses “a media player that receives media from a remote system via said computer network and plays said media in response to customer requests (Col 5, line 43 through Col. 6, line 12; and Col 7, line 55 through Col. 8, line 15). (Examiner's Action, page 3).

Column 5, line 43 through Col. 6, line 12 of Radziewicz are generally directed to the display of “messages, announcements or advertisements” (Column 5, lines 43-44), not media as defined in the present Application. The present Application specifically states “In the present invention as claimed, ‘media’ is not, however, defined to include advertisements, which are pitches for products or services that an advertiser pays to play.” (Present Application, paragraph [0010]).

Media has been further defined in amended Claim 1 to be selected from the group consisting of: audio music and music videos. The cited passage of Radziewicz does not disclose or suggest this element of amended Claim 1.

Col 7, line 55 through Col. 8, line 15 of Radziewicz are directed to types of announcements that may be transmitted by an announcement server 30, and the provision of a customized announcements and custom menu to subscribers. The announcements can be finance related announcements, automobile related announcements, or sports related announcements. Radziewicz, however, does not disclose or suggest playing media that consists of elements selected from the group consisting of audio music and music videos.

Therefore, Radziewicz does not disclose each and every element of the claimed invention of amended Claim 1 and as such, is not an anticipating reference. Nor, for analogous reasons, does Radziewicz disclose each and every element of amended independent Claims 8 and 15. Because Claims 2-7, 9-14 and 16-21 are dependent upon Claims 1, 8 and 15, respectively, Radziewicz also cannot be an anticipating reference for Claims 2-7, 9-14 and 16-21. Accordingly, the Applicants respectfully request the Examiner to withdraw the 35 U.S.C. §102(b) rejection with respect to these Claims.

#### IV. Conclusion

In view of the foregoing amendment and remarks, the Applicants now see all of the Claims currently pending in this Application to be in condition for allowance and therefore earnestly solicit a Notice of Allowance for Claims 1-21.

The Applicants request the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present Application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,

HITT GAINES, PC

A handwritten signature in black ink, appearing to read 'D. Hitt', is written over a large, faint, circular stamp or watermark.

David H. Hitt

Registration No. 33,182

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P.O. Box 832570  
Richardson, Texas 75083  
(972) 480-8800